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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,364	09/12/2003	Eric Meyerhofer	51091/RAG/F392	6757
5514	7590	12/15/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			CULLER, JILL E	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/661,364

Applicant(s)

MEYERHOFER ET AL.

Examiner

Jill E. Culler

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 14-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 24-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-34 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 14-23 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Group I. Claims 1-13 and 24-34, drawn to a multi-media gaming printer for printing on two or more types of cards, classified in class 400, subclass 149.

Group II. Claims 14-19, drawn to a method of operating a printer related to placing a card in escrow, classified in class 101, subclass 484.

Group III. Claims 20-23, drawn to a method of operating a printer related to cleaning a card, classified in class 101, subclass 425.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process can be practiced by an apparatus not having the ability to print on two or more types of cards, and the apparatus can be used to practice a process which does not involve placing a card in escrow.

Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP §

806.05(e)). In this case the process can be practiced by an apparatus not having the ability to print on two or more types of cards, and the apparatus can be used to practice a process which does not involve cleaning a card.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14-23 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "234", see Figure 3d.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "304", see page 14, line 11. Also, it is not clear how the description on lines 12-13 relates to the reference numeral 306 in Figure 4a.

The drawings are objected to because reference numeral "1152" in Figure 8 doesn't have an arrow so it's not clear what portion of the drawing it is meant to indicate.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 8, 10, 24, 31 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,364,550 to Petteruti.

With respect to claims 1, 8 and 10, Petteruti teaches a multi-media printer, 10, comprising: a print module including two or more heads, each head for reading and

writing a different type of card, the two or more heads selected from the group including a thermal card read/write head, 70, comprising a thermal write head and an optical read head, a magnetic strip card read/write head, 80, see column 4, lines 14-46, and a smart card connector, 232; a controller coupled to the two or more heads, 230, see column 4, lines 5-13 and column 5, lines 41-45, a media motion sensor, 201, and an external communication port, 110. See column 4, line 63 - column 5, line 23.

With respect to claims 24, 31 and 33, Petteruti teaches a multi-media printer, 10, comprising: a print module for manipulating cards comprising different types of media, the print module comprising: a first head, 70, for manipulating a first type of card; a second head, 80, for manipulating a second type of card, the first type of card and the second type of card being different card types; see column 4, lines 14-46, a controller for controlling the print module, see column 4, lines 5-13 and column 5, lines 41-45, a media motion sensor, 201, and an external communication port, 110. See column 4, line 63 - column 5, line 23.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petteruti in view of JP 05169762 to Asakawa.

Petteruti teaches all that is claimed, as in the above rejection of claims 1, 8, 10, 24, 31 and 33 except that the print module further comprises an articulated media drive coupled to the controller, the articulated media drive adjustable to accommodate media with various thicknesses.

Asakawa teaches an articulated media drive, adjustable to accommodate media with various thicknesses. See abstract.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Petteruti to have the articulated media drive of Asakawa in order to be able to process a wider variety of cards.

7. Claims 3-5 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petteruti in view of U.S. Patent No. 5,882,127 to Amano.

With respect to claims 3-4 and 26-27, Petteruti teaches all that is claimed, as in the above rejection of claims 1, 8, 10, 24, 31 and 33 except for a media magazine coupled to the controller and operable to receive and transmit media from and to the print module, and a media quantity sensor.

Amano teaches a printer having a media magazine, 21, coupled to a controller and operable to receive and transmit media from and to the print module, and a media quantity sensor, 55. See column 11, line 65 - column 12, line 16 and column 15, lines 54-58.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Petteruti to have the media magazine and quantity sensor of Amano in order to deliver media to the printer in a controlled manner.

With respect to claims 5 and 28, Petteruti teaches a read/write media information memory, 238. See column 6, lines 15-17 and Figure 9.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the memory of Petteruti with the media magazine structure taught by Amano in order to have better control over the media feeding process

8. Claims 6-7 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petteruti in view of U.S. Patent No. 5,326,179 to Fukai et al.

Petteruti teaches all that is claimed, as in the above rejection of claims 1, 8, 10, 24, 31 and 33 except for a media cleaner and a media cleanliness interrogator.

Fukai et al. teaches a printer having a media cleaner and a media cleanliness interrogator. See column 4, lines 14-38.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Petteruti to have the cleaning apparatus of Fukai et al. in order to be able to better prepare the cards for processing.

9. Claims 9, 11, 13, 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petteruti in view of JP 2002086970 to Arai et al.



With respect to claims 9 and 32, Petteruti teaches all that is claimed, as in the above rejection of claims 1, 8, 10, 24, 31 and 33 except for an embossing sensor.

Arai et al. teaches an embossing sensor, 40. See abstract.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Petteruti to have the embossing sensor of Arai et al. in order to be able to determine whether a card has embossing, and therefore better determine what type of card is being sensed.

With respect to claims 11, 13 and 34, Petteruti teaches all that is claimed, as in the above rejection of claims 1, 8, 10, 24, 31 and 33 except for an optical security feature head.

Arai et al. teaches a printer having an optical security feature head. See abstract.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Petteruti to use the optical security feature head of Arai et al. in order to check the validity of a card inserted in the apparatus.

10. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petteruti in view of U.S. Patent No. 5,122,754 to Gotaas

Petteruti teaches all that is claimed, as in the above rejection of claims 1, 8, 10, 24, 31 and 33 except for a capacitance type security feature head.

Gotaas teaches an apparatus having a capacitance type security head. See column 2, line 55 - column 3, line 14.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Petteruti to have the capacitance type security feature head of Gotaas in order to verify the genuineness of a card inserted in the apparatus.

### ***Response to Arguments***

11. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 3,947,691 to Goldstein, U.S. Patent No. 4,519,600 to Warwick et al., U.S. Patent No. 5,266,781 to Warwick et al., U.S. Patent No. 5,974,961 to Kazo et al., U.S. Patent No. 6,236,420 to Matsuzaka, U.S. Patent No. 6,313,856 to Ulrich, U.S. Patent No. 6,729,719 to Klinefelter et al., U.S. Patent No. 6,758,61 to Pribula et al., U.S. PGPUB 2001/0014246 to Luciano et al. and JP 10255118 to Kanda each teach a printing device having obvious similarities to the claimed subject matter.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill E. Culler whose telephone number is (571) 272-2159. The examiner can normally be reached on M-Th 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2854

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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